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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,296	08/10/2001	James C. Thomas JR.	45659/FLC/T503	4976

23363 7590 10/03/2005

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EXAMINER
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GORT, ELAINE L

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 10/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

*He*

**Office Action Summary**

Application No.

09/927,296

Applicant(s)

THOMAS, JAMES C.

Examiner

Elaine Gort

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 23-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. In view of the Appeal Brief filed on July 22, 2005, PROSECUTION IS HEREBY REOPENED. As set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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**3. Claims 23-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over GMcard.com in view of Examiner's Official Notice.**

GMcard.com discloses the claimed data processing system adapted to generate a link between a credit card account and another account (GMcard.com discloses obtaining \$5 in earnings for each \$100 spent on the associated credit card, these earned dollars are accumulated in an account that the user can later use as a rebate against a purchased vehicle);

Calculates a rebate amount based on a purchase amount charged to a credit card account using the credit card (rebate amount is calculated based on \$5 per \$100 spent on the associated credit card);

Identifies the account linked to the credit card account (the system inherently identifies the associated GM account in order to accumulate and track the earnings per year);

Crediting the rebate to the identified account linked to the credit card account (when purchases are made \$5 is credited to the associated and identified GM account for every \$100 spent on the credit card);

Applying the credited rebate amount to an amount due on the account (when the customer purchases a vehicle the amount due is reduced by the credited rebate amount, to generate an actual amount due from the customer to GM);

***But is silent regarding*** the specific use memory, executable program instructions and processors; and where the account linked to the credit card account is an insurance account.

Examiner takes Official Notice that the use of memory, executable program instructions and processors is notoriously old and well known in the art of credit card usage and accounting to provide automated use, tracking and billing of credit card accounts. It would have been obvious to one having ordinary skill in the art at the time the invention was made to perform the rebate calculation and crediting of GMcard.com with the use of memory, executable program instructions and processors of Examiner's Official Notice in order to provide automated use, tracking and billing of credit card accounts with rebates.

GMcard.com does not expressly show the claimed data including: where the credited account is an insurance account. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The program instruction steps would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Note that the system is "capable" of carrying out the claimed steps on any type of data and therefore is capable of crediting an insurance account.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to perform the step of generating a link, calculating a rebate, identifying the account, crediting the account and applying the rebate amount to the account using any type of data. Because such data does not functionally related to the steps in the method claimed and because the subjective interpretation of the data

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does not patentably distinguish the claimed invention. It further would have been obvious to carry out these claimed program instructions on an insurance account in order to promote a credit card to insurance customers in order to promote both card and the co-branded products being the insurance companies products.

Functional recitation(s) used in apparatus claims (e.g. "for charges made to a credit card as payment for insurance policies" as recited in claim 23) are given little patentable weight because they fail to add any structural limitations and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In re Casey, 152 USPQ 235 (CCPA 1967); In re Otto, 136 USPQ 458, 459 (CCPA 1963)

(Regarding claim 24) Examiner takes Official Notice that the use of Web Sites for viewing credit card account information is notoriously old and well known in the art of credit card billing to provide users with on-line up to date access to account information.

(Regarding claim 25) Where the rebate amount is a fixed percentage of the purchase amount on the credit card account (GMcard.com discloses rebating \$5 per \$100 charged to the card).

(Regarding claims 26-28) Examiner takes Official Notice that it is notoriously old and well known in the art of rebate calculations to utilize variable percentages for calculating credit card rebates for marketing purposes.

(Regarding claims 29-32) GMcard.com does not expressly show the claimed data including: where payments are made to pay premiums, type of insurance policy covered by the account, where payments are made to pay for an upgraded insurance policy, and where payments are made to make co-payments for services provided by an insurance policy. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The program instruction steps would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Note that the system is “capable” of carrying out the claimed steps on any type of data and therefore is capable of making payments to pay premiums, an upgraded insurance policy, and co-payments for services provided by an insurance policy to an insurance account for any type of insurance policy.

### ***Response to Arguments***

4. Applicant's arguments with respect to claims 23-32 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Cole (US Patent 5,850,217) discloses the general processing of credit card transactions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elaine Gort whose telephone number is (703)308-6391. The examiner can normally be reached on Monday through Thursday from 7:00 am to 5:30 pm.

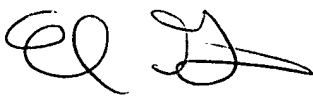
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elaine Gort whose telephone number is 571/272-6781. The examiner can normally be reached on Tuesday and Friday.



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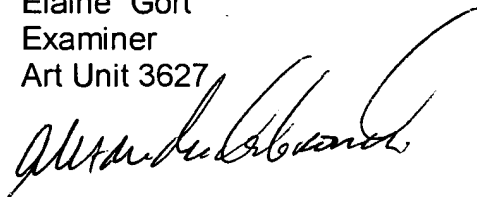
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571/272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



September 29, 2005

Elaine Gort  
Examiner  
Art Unit 3627



**ALEXANDER KALINOWSKI**  
**PRIMARY EXAMINER**